

## **REMARKS**

### **I. Status of Claims**

Prior to entry of this paper, Claims 1-30 were pending. **Claims 1-30 were rejected.** In this paper, Claims 1, 12, 21, and 30 are amended; no claims are cancelled or added. Claims 1-30 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, applicant's representative respectfully submits that each of the presently pending claims is in condition for allowance.

### **II. Claim Rejections - 35 U.S.C. § 101**

**Claim 30** was rejected under 35 U.S.C. 101 because the claimed invention was considered to be directed to non-statutory subject matter.

With this paper, Claim 30 has been amended to be directed to a particular type of computer readable media, that is, "computer readable storage media". The specification, at page 6, lines 5-14, discloses two types of computer readable media, "communication media" and "computer storage media". It is the first of these two types, "communication media", that is disclosed in the specification to embody a "carrier wave". However, it is this second of these two types, "computer storage media", to which amended Claim 30 is directed. Further support for this second type of computer readable media was provided in the specification as originally filed in lines 13-21 of page 7.

As amended, it is respectfully submitted that amended Claim 30 is directed toward statutory subject matter. The statutory nature of this subject matter is further discussed in MPEP 2106. In light of this amendment, withdrawal of the previous rejection under 35 U.S.C. §101 is respectfully requested.

### **III. Claim Rejections - 35 U.S.C. § 103**

**Claims 1-3, 5, 7, 9-14, 16, 18-23, 25 and 27-30** were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al., U.S. Patent No. 7,380,126 (hereinafter "Logan") in view of Rhodes, U.S. Patent Publication No. 2003/0220978 (hereinafter "Rhodes").

With this paper, independent claims have been amended to further clarify grounds of distinction, and thus patentability, between the inventions further claimed therein and the prior art of record. After carefully and thoroughly reviewing this prior art, including as it is applied in the most recent Office Action, it is respectfully submitted that Logan in view of Rhodes does not suggest at least the limitations of amended Claims 1, 12, 21, and 30 for at least reasons set forth as follows. It is particularly submitted that Logan in view of Rhodes does not suggest the limitations of these amended claims when such limitations are considered as a whole.

For example, amended Claim 1 at least recites:

*disabling the client's outbound message usage occurs prior to sending the composed message for the client over a network from a messaging system employed to originate each outbound message associated with the client, and wherein disabling the client's outbound message usage further includes disabling an ability of the client to send the composed message to the messaging system for sending to each recipient*

Support for this amendment can be found throughout the application as originally filed, including on page 3, lines 18-25 and page 10, lines 16-18 of the specification.

In contrast to this limitation, both of the systems of Logan and Rhodes involve the receipt of a sender's message at a recipient's messaging system. In both systems of Logan and Rhodes, this receipt – again, at the recipient's messaging system – is required before the sender's message encounters the possibility of not being further transmitted to, or viewed by, an intended recipient.

For example, in Logan, it is at the receiving Mail User Agent (MUA) that messages are “filtered, sorted or otherwise categorized” to “distinguish unwanted email” (col. 1, lines 61-65 and col. 4, lines 22-33). Even when the sending MUA notifies a user with a “warning” about a message, this message still “is transmitted” and “will be sent”, regardless of a sender’s actions after the warning message has been provided (col. 3, lines 53-57 of Logan). To reiterate, even after such a warning, the user of the system of Logan is able to “send the message without modification” (col. 3, lines 56-57 of Logan). Regarding a message that results in such a warning, Logan further states that unsigned mail will still be handled at the receiving MUA “in the usual way, but would become increasingly suspect as adoption of the anti-spam pledge mechanism becomes increasingly prevalent”. Clearly, such “usual” handling and “increasingly suspect” status of a message does not

suggest “*disabling the client’s outbound message usage*”, including when such disabling “*occurs prior to sending the composed message for the client over a network from a messaging system employed to originate each outbound message associated with the client*” and further comprises “*disabling the client’s outbound message usage further includes disabling an ability of the client to send the composed message to the messaging system for sending to each recipient*” as is further claimed in at least amended Claim 1.

With regards to the proposed combination of Logan and Rhodes, it is again particularly noted that the “warning message” operations in Logan do not prevent a subject sender from further sending messages, even including the message that caused the user to initially be notified with the warning message (col. 3, lines 53-57 of Logan).

It is respectfully submitted that Rhodes neither cures nor otherwise overcomes these deficiencies in Logan. For example, the disclosure of Rhodes also involves a mail server receiving a message “for which the mail server is a final destination” (para. [0031] of Rhodes). In the system of Rhodes, it is this same mail server, the recipient’s mail server, at which a received message causes a challenge message to be sent out, back across the network, to a sender while the received message is stored without being delivering to a recipient’s mail box (para. [0034] of Rhodes). Similar to the filtering of Logan, this process still occurs after the message is initially received over a network from a mail client and forwarded by mail transfer agents in communication with the recipient’s mail server (para. [0029-0030] of Rhodes). Accordingly, it is respectfully submitted that the execution of such a process on a “received message” in Rhodes does not suggest “*disabling the client’s outbound message usage*”, including when such disabling “*occurs prior to sending the composed message for the client over a network*” and comprises “*disabling an ability of the client to send the composed message to the messaging system for sending to each recipient*” as is further claimed in at least amended Claim 1. In particular contrast to the grounds of rejection cited in the most recent Office Action at page 4, lines 14-18, it is also respectfully submitted that the recipient’s mail server in Rhodes, is not “*a messaging system employed to originate each outbound message associated with the client*” as is further claimed in at least amended Claim 1. As such, it is respectfully submitted that Logan, even in combination with Rhodes, does not suggest all limitations of at least amended Claim 1.



purpose, which also renders invalid such a rejection under 35 U.S.C. §103 involving these references.

In light of the above discussion, it is again respectfully submitted that the proposed combination of Logan and Rhodes does not suggest all limitations of amended Claim 1, including when such limitations are considered as a whole. It is further respectfully submitted that, as also noted herein, the proposed combination is simply not substantiated or otherwise supported by the disclosures of the applied references. Finally, the proposed combination would render the primary reference unsuitable for its intended purpose of enabling recipients to sort and filter received messages. For each of these reasons, as well as the amended limitations of amended Claim 1, withdrawal of this rejection under 35 U.S.C. §103(a) is respectfully requested.

Independent **Claims 12, 21, and 30**, have been amended with similar, albeit different, limitations. For at least the same reasons listed above, the subject matter of these amended claims is respectfully submitted to be allowable over the prior art of record. For at least these reasons, withdrawal of the previous rejections under 35 U.S.C. §103 is also respectfully requested.

So far as dependent **Claims 2-3, 5, 7, 9-11, 13-14, 16, 18-20, 22-23, 25 and 27-29** depend from the above noted amended independent claims, it is respectfully submitted that these dependent claims also incorporate amended limitations and are not taught or suggested by the prior art of record for at least the same reasons listed herein for amended Claim 1. Accordingly, withdrawal of the previous rejections under 35 U.S.C. §103 for these claims is also respectfully requested.

**Claims 6, 8, 15, 17, 24 and 26** were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes and further in view of Wilson, U.S. Patent Publication No. 2004/0015554 (hereinafter "Wilson").

However, with this paper, these claims depend from amended Claim 1 or from amended claims that include limitations that are similar, albeit different to that discussed above with regards to amended Claim 1. It is respectfully submitted that the deficiency of Logan and Rhodes is not cured by the disclosure of Wilson. In fact, the system of Wilson also operates "[w]hen an email message arrives at the recipient's system" (para. [0053]). Accordingly, it is respectfully submitted

that, even when combined with the disclosure of Wilson, the limitations of these claims as a whole are not suggested by the combination of Logan, Rhodes, and Wilson. Accordingly, withdrawal of these rejections is respectfully requested.

**Claim 4** was rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes and further in view of Burrows et al., U.S. Patent No. 7,149,801 (hereinafter "Burrows").

However, so far as dependent **Claim 4** depends from amended Claim 1 further noted above, it is respectfully submitted that this claim incorporates the amended limitations of amended Claim 1 and is not taught or suggested by the prior art of record for at least the same reasons listed above.

It is further respectfully submitted that Burrows fails to cure the above noted deficiencies. Like other prior art discussed herein, Burrows also first requires the initial receiving (and hence outbound sending from an email client) of an email message "not from a white listed sender and without a stamp" (col. 25, lines 1-4). Similar to the operations of Logan and Rhodes, the operations of Burrows occur "if a message arrives" (col. 25, lines 47-51). As such, the system of Burrows is also a reactive system that fails to suggest at least the above reproduced limitation from amended Claim 1.

Accordingly, for at least this reason, withdrawal of the previous rejection of Claim 4 in view of these references under 35 U.S.C. §103 is also respectfully requested.

**CONCLUSION**

In view of the above amendment, applicant's representative believes the pending application is in condition for allowance.

Dated: November 7, 2008

Respectfully submitted,

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